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OFFICE OF PETITIONS

In re Application of

Von Arx, et al.

Application No. 10/801,236

Filing Date: 16 March, 2004

Attorney Docket No. 65,253-007

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DECISION ON PETITION

This is a decision on the petition filed on 23 July, 2004, and considered under 37 C.F.R. §1.53, to obtain a filing date of 16 March, 2004, for Fig. 2 as described in the specification.

The Office regrets the delay in addressing this matter.

The petition is **DISMISSED**.

BACKGROUND

This nonprovisional application was deposited on 16 March, 2004.

On 1 June, 2004, the Office mailed a "Notice of Omitted Items in a Nonprovisional Application," (the 1 June Notice) and indicated that, while a filing date had been granted, it appeared that Fig. 2 as described in the specification was omitted from the application.

The 1 June Notice informed Petitioner of three alternative responses to the Notice: (a) to contend that the materials had been submitted, providing evidence thereof and a copy of the materials; (b) to submit the omitted materials and accept the date of submission as the date of the application; or (c) to ignore the 1 June Notice and accept the application as filed.

Petitioner actually elected to do none of the above, in that while he has submitted the petition and fee he has submitted no evidence of deposit of the Fig. 2 on filing—though he apparently has

submitted drawings—including one identified as Fig. 2.

Petitioner:

- filed the instant petition on 23 July, 2004; and
- alleged that the instant application incorporated by reference the parent such that the presence of the drawing in the parent with the incorporation by reference results in there being no new matter if Fig. 2 as described in the specification is included in the instant application.

Analysis

A search of the official file reveals that on 16 March, 2004, Petitioner deposited the instant application, and stated therein on the first page of the specification that this was a “Divisional . . . of prior application n.: 10/055,683” filed on 23 January, 2002, and that “[t]he entire disclosure of the prior application . . . is considered as being part of the accompanying application and is hereby incorporated by reference.”

CONCLUSION

The petition is **dismissed**.

Because Petitioner asserts that the first paragraph of the specification states that the application is a continuation of Application Serial No. 10/055,683, filed on 23 January, 2002, and pending as of the filing of the instant application, and that application was incorporated by reference. This incorporation may be proper in practice before the Office. (See: MPEP §201.06(c) (in pertinent part)).¹ As a matter of expediting prosecution, Petitioner may submit a copy of the parent application (Application Serial No. 10/055,683) with a preliminary amendment and seek entry of

¹ The commentary at MPEP §201.06(c) provides in pertinent part:

INCORPORATION BY REFERENCE

In a continuation or divisional application, the safe-guard (petition and fee under former 37 C.F.R. 1.60(b)) concerning the filing of an application lacking all of the pages of the specification or sheets of drawings of the prior application has not been retained in 37 C.F.R. 1.53(b) since the specification and drawings of a continuation or divisional application are not limited to a reproduction or a “true copy” of the prior application. As a safeguard, however, an applicant may incorporate by reference the prior application by including, in the continuation or divisional application-as-filed, a statement that such specifically enumerated prior application or applications are “hereby incorporated herein by reference.” The statement may appear in the specification or in the application transmittal letter. The incorporation by reference statement can only be relied upon to permit the entering of a portion of the prior application into the continuation or divisional application when the portion of the prior application has been inadvertently omitted from the submitted application papers in the continuation or divisional application. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuation or divisional application to include any subject matter in such prior application(s), without the need for a petition provided the continuation or divisional application is entitled to a filing date notwithstanding the incorporation by reference. (Emphasis supplied.).

that amendment by the Examiner.)

No petition is required for that purpose.

This file (Image File Wrapper (IFW)) is released to OIPE for further processing consistent with this decision before being forwarded for examination in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.

A handwritten signature in black ink, appearing to read 'John J. Gillon, Jr.', with a stylized, cursive script.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions